

REMARKS

Eighteen claims are pending in the present Application. Claims 1-18 currently stand rejected. Claim 5 is amended, and new claim 19 is added herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 102(e)

On page 4 of the Office Action, the Examiner rejects claims 1-5 and 8-11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0041329 to Steinberg (hereafter Steinberg). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Steinberg fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claim 5, Applicants respond to the Examiner’s §102 rejection as if applied to amended claim 5 which now recites “*said digital camera being incapable of communicating with any external device other than said exclusive and remote location*”, which are limitations that are not taught or suggested either by the cited references, or by the Examiner’s citations thereto.

Steinberg essentially teaches a “messaging center” that sends various types of messages to a camera for display to a camera user (see Abstract). However, Steinberg also teaches that the camera can interface with “a programmable card” to exchange information “from the network through a computer 40 connected to the network by cables . . .” (see paragraph 0033). Applicants submit that the camera of Steinberg may also readily receive information from computer 40 that was obtained from sources other than the messaging center. In addition, the camera of Steinberg may also receive information from transceiver 18 that is transmitted to the “network” from sources other than the messaging center.

Furthermore, since the camera of Steinberg clearly communicates with computer 40, Steinberg therefore fails to disclose “*said digital camera being incapable of communicating with any external device other than said exclusive and remote location*”, as claimed by Applicants. Independent claims 1 and 9 recite similar limitations, and the foregoing arguments apply equally to claims 1 and 9.

Furthermore, on page 6 of the Office Action, the Examiner states that page 3, paragraph 39 of Steinberg implies that “the digital camera (14) must send image data (quantity of images, type of images) to the remote storage device 12.” Applicants respectfully disagree with this interpretation of Steinberg. Applicants submit that Steinberg nowhere states that image data is uploaded from the camera to the messaging center. Applicants submit that “other information such as the quantity of images taken by a camera, the type of images etc. . . .” is not the same as the actual image data.

The Examiner infers that, in order to build a “user profile”, the advertisement center would need to download the actual image data. Because of the substantial magnitude of the data transfers required to provide the actual image data to the advertisement center, Applicants submit that the camera of Steinberg instead more efficiently provides only the “quantity of images” and the “type of images”, as actually disclosed by Steinberg. For at least the foregoing reasons, Applicants submit that Steinberg fails to teach uploading “image data from a digital camera solely to an exclusive and predetermined remote location”, as claimed by Applicants.

Regarding the Examiner’s rejection of dependent claims 2-4, 8, and 10-11, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-4, 8, and 10-11, so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Steinberg to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of claims 1-5 and 8-11, so that these claims may issue in a timely manner.

35 U.S.C. § 103

On page 10 of the Office Action, the Examiner rejects claims 5-7 and 12-18 under 35 U.S.C. § 103 as being unpatentable over Steinberg in view of U.S. Patent No. 6,442,529 to Krishan et al. (hereafter Krishan). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Steinberg according to the teachings of Krishan would produce the claimed invention. Applicants submit that Steinberg in combination with Krishan fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Steinberg nor Krishan contain teachings for combining the cited references to produce the

Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 5-7 and 12-18, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 5-7 and 12-18, so that these claims may issue in a timely manner.

In addition, the Examiner explicitly concedes that Steinberg "fails to distinctly state that the digital camera is unable to exchange electronic information with any electronic devices except for the exclusive and predetermined location." Applicants concur. The Examiner then points to Krishan to purportedly remedy these defects.

Krishan teaches advertisers subsidizing Internet access through "mini-portal devices" (see column 3, lines 38-45). However, Krishan explicitly teaches variously communicating with a "validation server", an "advertisement server", a "content server", and a "statistics server". Applicants therefore submit that neither of the cited references teach "*said digital camera being incapable of communicating with any external device other than said exclusive and remote location*", as claimed by Applicants. In addition, Applicants submit that neither of the cited references teach "uploading image data", as claimed by Applicants.

Furthermore, with regard to dependent claims 16 and 17, Applicants submit that neither of the cited references teach a “*combined download/upload request*”, as claimed by Applicants. For at least the foregoing reasons, the Applicants submit that claims 5-7 and 12-18 are not unpatentable under 35 U.S.C. § 103 over Steinberg in view of Krishna, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 5-7 and 12-18 under 35 U.S.C. § 103.

New Claim

The Applicants herein submit additional claim 19 for consideration by the Examiner in the present Application. The new claim 19 recites a specific detailed embodiment for implementation and utilization of Applicants’ invention, as disclosed and discussed in the Specification. Applicants submit that newly-added claim 19 contain a number of limitations that are not taught or suggested in the cited references. Applicants therefore respectfully request the Examiner to consider and allow new claim 19, so that this claim may issue in a timely manner.

Examiner Interview Summary

On December 15, 2005, Applicants' representative, Gregory Koerner, held an Examiner's Interview with Examiner Kelly Jerabek to discuss various differences between the cited references and Applicants' claimed invention. Applicants argued that neither Steinberg nor Krishan teach "said digital camera being incapable of communicating with any external device other than said exclusive and remote location", as recited in claim 5. In addition, Applicants argued the neither Steinberg nor Krishan teach "uploading image data", as recited in claim 5. Finally, Applicants argued that neither Steinberg nor Krishan teach a "combined download/upload request" as recited in claims 15 and 16.

Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-19, so that the present Application may issue in a timely manner. If there are any questions concerning this Response, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

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By: 

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